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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,943	05/13/2005	Craig B Gentry	6655P008	1694

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EXAMINER
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WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
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3685

MAIL DATE	DELIVERY MODE
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10/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/534,943	<b>Applicant(s)</b> GENTRY ET AL.	
	<b>Examiner</b> Jalatee Worjloh	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 3-6 and 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-12-07; 8-22-05</u>   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species A in the reply filed on September 15, 2008 is acknowledged.
2. Claims 1-24 are pending.

### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings are informal (see Figure 9). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: FSP and HSP are not defined in paragraph [0007] of the Specification.

Appropriate correction is required.

### ***Priority***

5. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in PCT/US2004/003438 on 2/6/2004 (see Oath and Declaration). It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1, 14, 23, and 24 recite providing one or more tokens to the foreign service provider with the next packet if the foreign service provider accepts the signature.

- a. How can "the next packet" be provided if a first packet has not been provided?
- b. How is the provider accepting the signature? Is the provider verifying the signature?

9. Claims 1, 14, 23, and 24 recite continuing to use the service while the foreign service provider accepts tokens. However, the service was not initially utilized, only a request was made.

10. Claims 3, 10, and 14-16, 18 are considered hybrid claims. See MPEP §2173.05(p) II.

In particular, the claims are directed to neither a "process" or a "machine" but rather embrace or overlap two different statutory classes of invention as set forth in 35 U.S.C. §101.. For example, claim 3 recite " A method." In light of this evidence, one of ordinary skill in the art could reasonably interpret these recitations as express intent by Applicant(s) to claim a product claim. Alternatively, claim 3 also recites " the user device generates....". Also, claim 14 recites

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“An apparatus” and “the processor generates”, which is a process. One of ordinary skill in the art could also reasonably interpret these recitations as express intent by Applicant(s) to claim a process claim. In light of this conflicting evidence, a person of ordinary skill in the art could reasonably interpret claim 3 to be drawn to both a product or process.

Therefore in accordance with §2173.05(p) II which states that a single claim must be drawn to either a product or process (but not both) and because a potential competitor of Applicant(s) would not know whether *possession alone* of the claimed structure constituted infringement, or alternatively, if infringement required the *execution* of the recited method steps, the claims are indefinite. If Applicant(s) overcome this particular 35 U.S.C. §112, 2<sup>nd</sup> paragraph rejection, the related 35 U.S.C. §101 rejection will also be withdrawn. For examination purposes, the Examiner will interpret claims 3 as claims directed to a process only.

11. Claim 7 recites the limitation "the user device" in line 1. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 8 recites the limitation "the user device" in line 1. There is insufficient antecedent basis for this limitation in the claim.

13. Claims 11 and 20 recite "their service provider", which service provider are being referenced? Is it the home service provider? Is it another service provider?

14. Claim 13 recites the limitation "the monetary value" in line 4. There is insufficient antecedent basis for this limitation in the claim.

15. As per claim 13, it is unclear when these steps occur. In claim 1, a signature is generated on a root value of the hash tree and the signature and the value is sent to the foreign service

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provider. Claim 13, provides the root value to a home service provider for signature; is the signature that was previously generated?

16. Claim 13 recites "informing the home service provider of the monetary value of the dense hash". How is this being done?

17. Also, claim 13 recites "providing payments based on the tree to the foreign service provider", are these payments the same as the token, which Specification describes as microcredit tokens? Claim 1 recites the conditional element "if", which implies that the payment/token does not have to be provided to the foreign service provider. If it is not provided then this step would not be possible.

18. As per claims 11 and 20, it is unclear how the trusted party attests to the relationship between the user and their service provider.

19. Claim 22 recites the limitation "the monetary value" in line 3. There is insufficient antecedent basis for this limitation in the claim.

20. As per claim 22, it is unclear when these steps occur. In claim 1, a signature is generated on a root value of the hash tree and the signature and the value is sent to the foreign service provider. Claim 14, provides the root value to a home service provider for signature; is the signature that was previously generated?

21. Claim 22 recites "informs the home service provider of the monetary value of the dense hash." How is this being done?

22. Also, claim 22 describes providing payments based on the tree to the foreign service provider, are these payments the same as the token, which Specification describes as microcredit tokens? Claim 1 recites the conditional element "if", which implies that the payment/token does

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not have to be provided to the foreign service provider. If it is not provided then this step would not be possible.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

23. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

24. As per claim 1, based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.<sup>2</sup> If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. § 101

25. As per claims 3 and 10, 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). The applicants claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a system, but subsequently the claims then deal with the specifics of a method (the steps) executed by the processing means (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972).

statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

### ***Claim Objections***

26. Claims 3, 4, 6 and 12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

27. As per claim 3, see 35 USC 112, 2<sup>nd</sup> paragraph rejection above (Hybrid claim).

28. As per claim 4, this claim is not limiting the actually method steps (e.g. generating). Applicant should consider revising the claim to recite "wherein the generating a hash tree comprises a dense hash tree, and further comprising constructing...".

29. As per claims 6 and 12, this claim does not limit the method steps.

### ***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 1-3 and 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Publication No. 2003/0061170 to Uzo in view of U.S. Patent No. 4309569 to Merkle.

Referring to claim 1, Uzo discloses requesting a desired service through a foreign service provider (paragraph [0215]), sending a digital signature and a root value to the foreign service provider (see paragraph [0141] - the token has the signature), providing one or more tokens to



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the foreign service provider with the next packet if the foreign service provider accepts the signature and continuing to use the service while the foreign service provider accepts tokens (see paragraph [0215]). Uzo does not expressly disclose generating a hash tree and generating a digital signature on a root value of the hash tree. Merkle discloses generating a hash tree and generating a digital signature on a root value of the hash tree (see claim 1). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Uzo to include the features of Merkle. One of ordinary skill in the art would have been motivated to do this because it provides a means for authenticating messages (see Merkle, abstract).

Although the conditional elements have been considered, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See MPEP §2106 II. C: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"

As per claims 2 and 3, the combination of Uzo and Merkle discloses the features (see claim 1 rejection above).

As per claims 7-13, Uzo in view of Merkle discloses this concept (see claim 1 rejection above).

Claims 14-24 are rejected on the same rationale as claims 1-3 and 7-13 above.

***Allowable Subject Matter***

32. Claims 4-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph [and other informalities] set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Although Applicant(s) use “means for” in the claim(s) (*e.g.* claims 20-24), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. §112 6<sup>th</sup> paragraph should not be invoked. Alternatively, if Applicant(s) desire to invoke 35 U.S.C. §112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. §112 6<sup>th</sup> paragraph, the “means for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*.<sup>3</sup> Failure by Applicant(s) in their next response to also address the 35 U.S.C. §112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. §112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

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<sup>3</sup> Federal Register, Vol 65, No 120, June 21, 2000.

***Conclusion***

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 6339765 to Maher.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685